

REMARKS

Claims 1-30 are pending in the application and are presented for the Examiner's review and consideration. Claims 1-4, 7-10, 12, 13, 19, 23, and 27-30 have been amended. Applicant believes the claim amendments and remarks herein serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents. No new matter has been added.

Allowable Subject Matter

Applicant acknowledges with appreciation that claims 10-12, 16-22, and 27 were indicated as being allowable if rewritten in independent form. In this Response, Applicant has not rewritten the claims in independent form pending the Examiner's consideration of the claim amendments presented herein.

35 U.S.C. §102 Rejection

Claims 1 and 29 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,889,066 to Neil *et al.* ("Neil"). In response, Applicant respectfully submits that this rejection should be withdrawn.

Neil discloses a self-propelled, submersible, two-man vehicle having a hull. The hull includes an upper hull wall and a lower hull wall. The hull walls may be made of fiberglass and are shaped to obtain the lowest possible coefficient of friction. The hull includes a cockpit having side walls and end walls forming the enclosure of the cockpit. (col. 3, lns. 29-53). The hull defines an open accessway to the cockpit to allow passengers unimpeded access to the cockpit from the underside of the hull. Means are provided for supplying air to the cockpit to form an air bubble large enough to allow the passengers to breathe freely with the cockpit. (col. 1, lns. 53-58).

In contrast, Applicant discloses a modular watercraft capable of both surface and submersible accommodation of passengers. The watercraft can dive below the surface of the

water and can accommodate surface travel in a model akin to a conventional speedboat. (p. 2, lns. 17-21). As shown in Figures 1 and 2, the hull is generally V-shaped like a conventional speedboat. Also, the watercraft includes a sealable, pressurizable passenger compartment. (p. 4, lns. 2-3).

Applicant contends that Neil fails to teach or suggest all the elements of amended claim 1. For example, claim 1 recites, *inter alia*, a novel combination of different watercraft modules with the hull module including a V-shaped speedboat-like hull. Neil's hull, on the other hand, has a flat bottom, as seen in Figure 2. Also, Neil's hull has an accessway on the underside. Applicant contends that Neil's hull is not a V-shaped speedboat-like hull.

Applicant further contends that Neil fails to teach or suggest all the elements of amended claim 29. For example, claim 29 recites, *inter alia*, a novel combination of watercraft modules including a sealable, pressurizable passenger compartment module. That is, Applicant's passenger compartment maintains atmospheric pressure and relies on the structural support of the passenger module to withstand the compressive forces of the surrounding water. In contrast, as previously described, Neil's passenger compartment has an open bottom cockpit with an air bubble inside. As such, Neil's cockpit is not a pressurizable cockpit. Rather, the air bubble equalizes the pressure inside the cockpit relative to the water pressure outside the cockpit.

Accordingly, Applicant submits that amended claims 1 and 29 are not anticipated by Neil and are therefore patentable over the cited reference.

35 U.S.C. §103 Rejections

Claims 2-7, 28, and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Neil in view of U.S. Patent No. 4,458,618 to Tuffier ("Tuffier"). In response, Applicant respectfully submits that this rejection should be withdrawn.

As previously provided, Neil discloses a self-propelled, submersible, two-man vehicle. The vehicle can be used as a diving platform at various depths whereby one of the divers will remain in the vehicle, while the other diver can leave the vehicle and return to the vehicle for air. (col. 5, lns. 46-50).

Tuffier discloses a device that renders unsinkable a boat such as a habitable boat having a cabin and a cockpit. The device includes three inflatable envelopes two of which are placed on

starboard side and port side bunks, and the other envelope is placed on the floor of the cabin.
(abstract).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (MPEP §2143).

Initially, Applicant respectfully contends that there is no suggestion or motivation to combine Neil and Tuffier. Neil teaches a watercraft which is submersible. Tuffier teaches a device to make a watercraft non-submersible. Applicant submits that neither the references themselves nor the knowledge of one with ordinary skill in the art would provide motivation to combine a submersible watercraft with a device to make a watercraft non-submersible.

Applicant further contends that no reasonable expectation of success is achieved in combining Neil and Tuffier. As previously explained, Neil teaches a submersible watercraft. Therefore, to modify Neil's submersible watercraft with Tuffier's safety device for rendering a boat unsinkable would produce a submersible watercraft which would be prevented from submersing. Therefore, Applicant submits that no expectation of success is achievable with a non-submersible, submersible watercraft.

Furthermore, Applicant contends that Neil and Tuffier fail to teach all the claim elements of the rejected claims. Claims 2-7 depend from amended claim 1. As explained above, Applicant submits that amended claim 1 includes a unique combination of watercraft modules having at least one element that is patentable over the cited references. Therefore, based on their dependencies, Applicant submits that claims 2-7 are patentable as well. Regarding independent claim 28, Applicant has amended this claim to include, *inter alia*, wherein the hull provides for surface transport like conventional above-water surface watercraft. Applicant contends that at least this element of claim 28 is not taught or suggested by the cited references. With respect to claim 30, this claim depends from claim 29. As previously explained, Applicant submits that amended claim 29 is patentable over the cited references, and therefore, based on its dependency, not all the elements of claim 30 are taught by the cited art.

Claims 8, 9, and 23-26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Neil in view of U.S. Patent No. 4,494,472 to Rougerie ("Rougerie"). In response, Applicant respectfully submits that this rejection should be withdrawn.

Neil discloses a self-propelled, submersible, two-man vehicle, while Rougerie teaches a floating, non-submersible nautical craft. As such, Applicant contends that neither the references themselves nor the knowledge of one with ordinary skill in the art would provide motivation to combine the teachings of Neil's submersible watercraft with the teachings of Rougerie's non-submersible nautical craft. Also, Applicant submits that no expectation of success is achievable by combining Neil's submersible watercraft and Rougerie's non-submersible watercraft. Finally, Applicant contends that Neil and Rougerie fail to teach all the claim elements of the rejected claims. Claims 8, 9, and 23-26 depend from amended claim 1. As explained above, Applicant submits that amended claim 1 includes a unique combination of watercraft modules having at least one element that is patentable over the cited references. Therefore, based on their dependencies, Applicant submits that claims 8, 9, and 23-26 also include at least one patentable element.

Based on the foregoing, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. As such, Applicant submits that claims 2-7, 28, and 30 are patentable over Neil in view of Tuffier. Applicant also submits that claims 8, 9, and 23-26 are patentable over Neil in view of Rougerie.

Claims 13-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Neil in view of U.S. Patent No. 4,928,614 to Forman ("Forman"). In response, Applicant respectfully submits that this rejection should be withdrawn.

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Claims 13-15 depend from amended claim 1. As explained above, Applicant submits that amended claim 1 is patentable over the cited references. Based on at least their dependencies, Applicant submits that claims 13-15 are patentable as well.

Conclusion

In light of the foregoing remarks, this application is now in condition for an examination on the merits, and early action is respectfully requested. If any questions remain regarding this response or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned. Please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 503410 (Docket No. 7940-A03-003).

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Chris Menke", with a long horizontal flourish extending to the right.

Christopher J. Menke, Reg. # 53,316
for Paul Bianco, Reg. # 43,500

Customer Number: 33771
FLETT KAIN GIBBONS GUTMAN BONGINI & BIANCO
21355 East Dixie Highway
Suite 115
Miami, Florida 33180
Tel: 305-830-2600 Fax: 305-830-2605